

REMARKS

In response to the Final Office Action mailed December 13, 2006, Applicants make the following remarks.

Applicants filed a response to the previous Office Action on September 18, 2006. In that response, Applicants argued (see, e.g., pages 9-10) that one of skill in the art at the time of the invention would not have been motivated to combine Kalmanash (U.S. Patent No. 5,211,463, "Kalmanash") and Tatsuaki et al. (EP 0 798 507, "Tatsuaki") in the manner proposed by the Examiner. In the Final Office Action, the Examiner has chosen to address certain of Applicants' arguments relating to whether either Kalmanash or Tatsuaki discloses light source elements that include "a surface lying opposite the light exit face, and at least some of lateral surfaces connecting the light exit face and the opposite surface being covered with reflectors that contact the surfaces." (See Final Action at pages 3-7). However, the Examiner has not addressed Applicants' arguments regarding the motivation to combine Kalmanash and Tatsuaki. In the absence of a motivation to combine Kalmanash and Tatsuaki, the balance of the Examiner's arguments are moot; there can be no structure resulting from the combination of Kalmanash and Tatsuaki if one of skill in the art at the time of the invention would not have been motivated to combine these disclosures.

According to MPEP 707.07(f), "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Applicants submit that the Final Office Action does not comply with this requirement. Accordingly, Applicants request that the Examiner either address Applicants' arguments regarding the motivation to combine Kalmanash and Tatsuaki, or acknowledge that there would have been no motivation to combine these teachings as alleged.

In Applicants' response to the previous Office Action, filed on September 18, 2006, Applicants also made arguments for the patentability of certain dependent claims, including claim 37 (pages 11-12), claim 41 (page 12), and claim 28 (pages 12-14). In the Final Office Action, the Examiner has also failed to address any of these arguments. Instead, the Examiner has simply repeated the previous rejections of these claims, without any further explanation or discussion of Applicants' positions. In view of MPEP 707.07(f) cited above, Applicants request

that the Examiner either address Applicants' arguments regarding each of these dependent claims, or acknowledge that each of these claims is patentable over each of the prior art references cited by the Examiner.

Furthermore, in addition to failing to address many of Applicants' arguments, the Examiner has incorrectly characterized Applicants' arguments and positions in the "Response to Arguments" on pages 20-22 of the Final Office Action. The Examiner states that:

Applicant's ONLY substantive arguments are as follows:

- (1) Regarding base claims, applied prior art does not teach reflectors in contact with lateral surfaces.
- (2) Dependent claims are allowable because they directly or indirectly depend from an allowable base claim. (Final Office Action at page 20)

Applicants traverse. With regard to point (1) above, Applicants agree that the applied prior art does not teach reflectors in contact with lateral surfaces. However, this is not Applicants' ONLY substantive argument with regard to the independent claims. As discussed above, Applicants have also argued that there would have been no motivation for one of skill in the art at the time of the invention to combine Kalmanash and Tatsuaki in the manner proposed by the Examiner, which argument the Examiner has failed thus far to address.

With regard to point (2) above, Applicants agree that the dependent claims are allowable because they depend from allowable independent claims. However, this is not Applicants' ONLY substantive argument with regard to the dependent claims. As discussed above, Applicants have submitted additional arguments for the patentability of claims 37, 41, and 28, which arguments the Examiner has failed thus far to address.

Therefore, the Examiner's characterization of Applicants' position with regard to both the pending independent and dependent claims is incorrect. Applicants request that the Examiner withdraw the comments identified in points (1) and (2) above.

Finally, the Examiner continues to suggest that Applicants, in electing not to argue for the patentability of certain dependent claims and instead reserving the right to do so in future, have acquiesced the Examiner's rejections. The Examiner states that "[i]t is respectfully pointed out

that in so far as Applicant has not argued rejection(s) of the limitations of dependent claim(s), Applicant has acquiesced said rejection(s)." (Final Office Action at page 22). The Examiner also states that "[f]ailure to respond to any rejection rationale consummates acquiescence to said rejection rationale." (Final Office Action at page 22). Applicants traverse, for at least the following reasons.

First, Applicants have made clear that by electing not to respond to certain arguments of the Examiner in a given Action, and instead reserving the right to respond to the Examiner's arguments at a later time, Applicants neither implicitly nor explicitly acquiesce the Examiner's rejections. In fact, in the response to the Office Action filed on September 18, 2006, Applicants stated explicitly that:

Applicants wish to make clear that, contrary to the Examiner's unilateral and unsubstantiated assertion on page 20 of the Office Action, Applicants DO NOT concede ANY of the Examiner's rejections of ANY dependent claims in this application, whether or not Applicants have chosen to specifically address rejections directed to particular dependent claims in prior communications with the Office or in the current communication." (Office Action Response, page 11).

Thus, it is clear from Applicants previous remarks of record that Applicants have not acquiesced any of the Examiner's claim rejections, nor did Applicants have any intent to do so.

Second, the Examiner has not cited any authority or basis for his unsubstantiated allegation that Applicants have acquiesced certain of his rejections. The Examiner continues, in each subsequent Office Action, to assert that Applicants' election not to traverse certain of the Examiner's allegations constitutes acquiescence to said allegations. However, Applicants is not aware of any legal authority for the Examiner's position. Therefore, Applicants respectfully request that the Examiner either provide said authority, or withdraw these allegations.

In view of the foregoing, Applicants request that the Final Office Action of December 13, 2006 be VACATED, and that either: (a) a new Office Action is issued which is fully responsive to each of Applicants' arguments; or (b) a Notice of Allowance is issued.

Applicant : Franz Schellhorn et al.
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Page : 5 of 5

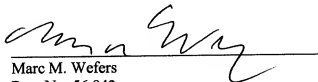
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Respectfully submitted,

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